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Kiyoshi Matsutani

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EXAMINER

BORLINGHAUS, JASON M

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/839,495	<b>Applicant(s)</b> MATSUTANI, KIYOSHI	
	<b>Examiner</b> JASON M. BORLINGHAUS	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Acknowledgements**

Examiner acknowledges the perfected foreign priority paperwork with backdates the present application to October 13, 2000. As such, prior art reference Berger (US PG Pub. 2002/0103752) is invalidated due to its date.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 3 – 5 and 15** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 3** claims “providing means for providing said taste information with a top priority while one of a shop and facilities are retrieved.”

First, Examiner believes that this claim is demonstrating circular logic. Claim 3 states that means extracts "taste information of a user based upon" shop or facilities use information. Such claim indicates that information concerning shop and facilities is available, as to allow corresponding taste information to be obtained. Then, Claim 3 states a means "for providing said taste information with a top priority" while shop or facilities information is retrieved. Examiner is uncertain how taste information can be given top priority while shop or facility information is retrieved, when taste information is defined by the very information it has yet to retrieve.

Second, Claim 3 should claim “providing means for providing said taste information with a top priority while one of a shop use historical information and facilities use historical information ~~are~~ is retrieved.” “

**Claim 15** suffers from similar issues.

Dependent claims are rejected based upon their dependency to earlier rejected claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 – 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gopinathan (US Patent 5,819,226) and Mockett (US 2001/0034702).

**Regarding Claim 1**, Gopinathan discloses an information terminal apparatus comprising:

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- communication means (data network) for transmitting and receiving information among the said communication means, and a server (financial data facility). (see col. 3, lines 34 – 55);
- processing means for executing a comparison process (comparing) as to both historical information (historical data on individual transactions) and balance account (available credit or balance). (see fig. 8; col. 5, line 50 - col. 7, line 5; col. 26, line 64 - col. 27, line 2);
- said historical information being contained in the transmission and reception information of said communication means. (see col. 3, lines 34 – 55; col. 5, line 50 - col. 7, line 5); and
- output means for outputting predetermined comparison result information based upon the comparison process result by the processing means. (see fig. 8).

Gopinathan does not explicitly disclose that the apparatus communicates with a server of a credit card firm and a server owned by a settling financial institution; nor obtaining information from said servers for a comparison process, although Gopinathan does disclose that to create a comparison requires access to past financial data such as is provided by “credit-card authorization terminals and automated teller machines.” (see col. 3, lines 34 – 55).

Mockett discloses an apparatus comprising communication means (Internet) for transmitting and receiving information among the said communication means, a server of a credit card firm (credit card approval network), and a server owned by a settling

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financial institution which settles a charge requested from said credit card firm (automated clearing house/merchant bank). (see fig. 1; para. 17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Gopinathan to incorporate the features disclosed by Mockett, allowing a payment fraud detection system to communicate with the system components that actually enable and perform the payment functions.

**Regarding Claims 2 – 6 and 8,** Gopinathan discloses an apparatus wherein:

- said processing means comprises periodic charge information (transactions from the period) extracting means for extracting periodic charge information (transactions from the period) from the credit card charge historical information. (see col. 27, lines 3 – 63);
- prediction means for predicting an estimated charge amount (dollar amount spent in each SIC; transaction amount) based on said extracted periodic charge information. (see col. 7, line 32 – col. 8, line 35; col. 19, lines 10 – 16);
- said processing means executes the comparison process as to said credit card charge historical information containing said estimated charge amount and said balance account information. (see col. 7, line 32 – col. 8, line 35; col. 19, lines 10 – 16);
- taste information extracting means for extracting taste information of a user based upon shop use historical information (merchant category code,

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merchant ZIP code) which are contained in the credit charge historical information. (see col. 26, line 64 - col. 27, line 2);

- storage means (data storage) for storing therein the taste information extracted by said taste information extracting means. (see fig. 1; col. 3, lines 34 – 55);
- storage means is constituted by a non-volatile storage medium (ROM and disk storage devices). (see col. 3, lines 55 – 65); and
- said storage means (disk) is arranged in such a manner that the taste information can be replaced with respect to an external appliance, while said storage means is detachably mounted on the information terminal apparatus, or is communicated to the external appliance. (see col. 3, lines 55 – 65);
- an input means for inputting (from database) first identification (PIN) of the user. (see col. 26, line 64 - col. 27, line 2); and
- identifying means (PIN) for judging (verification) as to whether or not said user can use the credit card based upon said first identification information entered by said inputting means. (see col. 26, line 64 - col. 27, line 2);

Gopinathan does not teach an apparatus wherein said input means inputs second identification information which is transmitted from the communication means to both the credit card firm and the server of the settling financial institution so as to identify the user.

Mockett discloses an apparatus wherein said input means inputs second identification information (dynamic credit card number) which is transmitted from the communication means to both the credit card firm and the server of the settling financial institution so as to identify the user. (see para 27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Gopinathan and Mockett to include communication the usage of a second user identifier, as disclosed by Mockett, thereby providing increased user authentication and system security.

**Claims 7 and 9 – 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gopinathan and Mockett, as applied to Claim 1 and 6 above, and further in view of Hassett (US Patent 6,653,946).

**Regarding Claim 7**, Gopinathan does not teach an apparatus wherein said input means utilizes a remote control operation by way of a wireless communication.

Hasset discloses an apparatus wherein said input means utilizes a remote control operation by way of a wireless communication. (see col. 1, line 64 to col. 2, line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Gopinathan and Mockett to include wireless communication, as disclosed by Hasset, thereby providing apparatus mobility and increasing ease of remote communication.

**Regarding Claims 9 – 15**, Gopinathan discloses an apparatus comprising:



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- said processing means executes a comparison process as to the credit card charge historical information (historical data on individual transactions) and the balance account information (available credit or balance). (see fig. 8; col. 5, line 50 - col. 7, line 5; col. 26, line 64 - col. 27, line 2); and
- taste information extracting means for extracting taste information of the user based upon either shopping historical information (historical data on individual transactions). (see fig. 8; col. 5, line 50 - col. 7, line 5; col. 26, line 64 - col. 27, line 2).

Gopinathan does not teach an apparatus comprising means for monitoring operation conditions of said communication means; warning means for issuing a warning notice in the case that an abnormal operation is confirmed by said monitoring means; releasing means for releasing the operation of either said monitoring means; said monitoring means confirms the abnormal operation of the communication function under such a state that the operation of said monitoring means is not released by the releasing means, the warning notice is issued by said warning means; said communication means is further comprised of positional move sensing means for sensing a positional move of said communication means; when at least one of unauthorized information and incorrect information into said releasing means under such a state that the operation of the monitoring means is not released by the releasing means, the warning notice is issued by said warning means; said processing means executes a comparison process as to toll road fee historical information supplied from

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an electric toll collection system; nor said information terminal apparatus is mounted on a mobile object

Hassett discloses an apparatus comprising:

- monitoring means (signal strength evaluation unit) for monitoring operation conditions of said communication means. (see 11, lines 1 - 13);
- warning means (beeper and red blinking red light alarm) for issuing a warning notice in the case that an abnormal operation (invalid IVC) is confirmed by said monitoring means. (see col. 30, lines 22 – 42);
- releasing means for releasing (resetting) the operation of either said monitoring means (signal identification information) used to identify the user. (see col. 30, lines 22 – 42);
- said monitoring means confirms the abnormal operation of the communication function under such a state that the operation of said monitoring means is not released by the releasing means, the warning notice is issued by said warning means (alarm module). (see col. 21, lines 26 - 31);
- said communication means is further comprised of positional move sensing means for sensing a positional move of said communication means. (see col. 4, lines 57 - 67);
- when at least one of unauthorized information and incorrect information is entered into said releasing means under such a state that the operation of the monitoring means is not released by the releasing means, the warning notice is issued by said warning means (alarm module). (see col. 21, lines 26 - 31);

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- said processing means executes a comparison process as to toll road fee historical information (toll charges) supplied from an electric toll collection system. (see col. 12, lines 36 – 48); and
- said information terminal apparatus is mounted on a mobile object (vehicle). (see col. 1, line 40 - col. 3, line 41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Gopinathan and Mockett to incorporate a toll payment device, as disclosed by Hassett, allowing the application of a fraud detection system, as disclosed by Gopinathan, and the application of an electronic payment system, as disclosed by Mockett, thereby providing enhanced security and automation.

### ***Response to Arguments***

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON M. BORLINGHAUS whose telephone number is (571)272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason M Borlinghaus/  
Examiner, Art Unit 3693

November 9, 2008